90-443

No. ____

IN THE

Supreme Court of the United States

OCTOBER TERM, 1990

KERN RIVER GAS TRANSMISSION COMPANY,
Petitioner,

v.

THE COASTAL CORPORATION,
COLORADO INTERSTATE CORPORATION,
COLORADO INTERSTATE GAS COMPANY,
COASTAL WESTERN PIPELINE COMPANY,
COLORADO INTERSTATE GAS WESTERN
PIPELINE COMPANY, and
WYOMING-CALIFORNIA PIPELINE COMPANY,
Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

(1) Whether the Fifth Circuit erroneously extended the "merger" doctrine, contrary to Section 102(a) of the United States Copyright Act, 17 U.S.C. § 102(a) and 200 years of judicial precedent, to preclude copyright protection for maps created on the basis of extensive field research, analysis and direct observation, thereby jeopardizing protection for all maps.

(2) Whether the Fifth Circuit erred in refusing to recognize a presumption of irreparable harm for purposes of determining the availability of preliminary injunctive relief pursuant to Section 502(a) of the Copyright Act, 17 U.S.C. § 502(a), in direct and acknowledged conflict with every other Circuit Court to consider that issue.

(3) Whether the copying of Petitioner's maps by Respondents for the purpose of obtaining regulatory approval for a competing proposal involving construction of a 1,000 mile natural gas pipeline constituted "fair use" under Section 107 of the Copyright Act, 17 U.S.C. § 107.

PARENT AND SUBSIDIARY CORPORATIONS

The following list of Petitioner's parent and subsidiary corporations is provided pursuant to Rule 29 of the Supreme Court Rules.

Petitioner is a Texas partnership formed by Tenneco Inc. and The Williams Companies, Inc.

AFFILIATES OF TENNECO, INC.

Adela Investment Company, S.A.
Akulu Marchon (PTY) Ltd.
Albright, Morarji and Pandit Limited
Albright & Wilson (Australia) Ltd.
Alcan Ekco Limited (United Kingdom)
A/S Haustrup-Ekco Aluminium-Emballage (Denmark)
AWAT Thai Ltd. (Thailand)
Bracey Petroleum Products Ltd.
Butler (1843) Ltd. (United Kingdom)
Case Proclain GmbH & Co.
Collins Pipeline Company
Consolidated Diesel Company (North Carolina Partnership)
Depositas Del Norte, S.A.
Establissement L. Bouilloux S.A. (France)
Ethoxylates Manufacturing Pte Ltd. (Singapore)
FC Marine Inc.
Gardinol Product (PTY), Ltd.
HT Gathering Company
Intertractor Viehmann GmbH & Co.
Kern Island Water Company
Kern River Canal and Irrigation Company
Kern River Gas Supply Corporation (Delaware)
Kern River Gas Transmission Company
Kern River Service Corporation (Delaware)
Losenhausen Maschinenbau AG & Co.
Losenhausen Machinebau AG

Marchon-Paragon Holdings (PTY) LImited
Marchon-Paragon Sulphonation (Cape) (PTY) Ltd.
Marchon-Paragon Sulphonation (PTY) Ltd.
Mistal Inc.
Monroe Auto Pecas S.A.
National Brands (PTY), Ltd.
Oasis Pipeline Company (Delaware)
Omni-Pac GmbH
P.P.M. Guindastes Hidraulicos S.A.
Polyphosphates Inc.
Poclain S.A.
Productora Andina de Acidos y Derivados Ltd. (Columbia)
SBG Puerto Rico, Inc. (Puerto Rico)
S.A. Paper Chemicals (Proprietary), Limited
Sara Gretes Cafeteria AB
Skogstre A/S
T&M Terminal Company
Tees Storage Company Limited
TENN-USS Chemicals Finance Corporation
Tenneco Automotive Foreign Sales Corporation Limited (Jamaica)
Tenneco Oil Company of Nigeria Unlimited
Tenneco Oil of Nigeria Unlimited
Tenngasco Gas Gathering Company
Trminales Quimicos S.A. (Spain)
Tess Storage Company Limited
Thai Polyphosphate & Chemicals Co. Ltd. (Thailand)
Toyo Ekco Company, Ltd. (Toyo Ekco Kubushiki, Kaisha) (Japan)
Tractortechnic Canada, Inc.
Tunisian American Date Company (Tunisia)
U.I. Case do Brasil & Cia.
Universal Chemical Contractors (PTY)
Vibromax France SARL
Vibromax France SCI
Vibromax SCI (France)
W.R. John & Company (Rumney) Ltd.

AFFILIATES OF THE WILLIAMS COMPANIES, INC.

The Williams Companies, Inc.
BankOklahoma Corp.
F T & T, Inc.
Kern River Gas Supply Corporation
Kern River Service Corporation
Langside Limited
Louisiana Gas Marketing Company
Louisiana Resources Company
NGL Production Company
Northwest Alaska Company
Northwest Energy Company
Apco Argentina Inc.
Apco Properties Ltd.
Diginet Incorporated
Northwest Alaskan Pipeline Company
Northwest Border Pipeline Company
Northern Border Pipeline Company
Northwest Canadian Gas Sales Company
Williams Field Services Company
Northwest International Company
Northwest Argentina Corporation
Northwest Investments, Incorporated
Silver Lake Knoll, Inc.
Northwest Land Company
Northwest Overseas Capital Corporation, N.V.
Northwest International Finance B.V.
Northwest International Finance N.V.
Northwest Pipeline Corporation
Prairie Transmission Lines Limited
Pacific Northwest Realty Corporation
Williams Natural Gas Company
Northwest Exploration Company
Realco Realty Corp.
Willcentre, Inc.Williams Center, Inc.
Realco Realty Developments, Inc.
Realco Realty Interest, Inc.

Realco of Crown Center, Inc.
Realco of San Antonio, Inc.
Realco of Utah, Inc.
Tulsa Williams Company
Williams Acquisition Holding Company, Inc.
Agrico Chemical of Oklahoma, Inc.
Agrico Disc, Inc.
Agrico Foreign Sales Corporation
Agrico Thailand, Inc.
Fishhawk Ranch, Inc.
Texasgulf Inc.
Willco, Inc.
Williams Exploration Company
Paraffine-Williams Company
Rainbow Resources, Inc.
Williams Gas Company
Williams Gas Management Company
Williams Gas Marketing Company
Williams Gas Supply Company
Williams Natural Gas Liquids Company
Williams Pipe Line Company
WillBros Terminal Company
Williams Terminals Company
Williams Relocation Services, Inc.
Williams Telecommunications Group, Inc.
Williams Telecommunications Services, Inc.
WTG - Central, Inc.
WTG - West, Inc.
WTG of California, Inc.
WTG Network, Inc.
Williams Western Pipeline Company

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OPINIONS BELOW

The opinion of the United States Court of Appeals for the Fifth Circuit is reported at 899 F.2d 1458 (5th Cir. 1990), and is reproduced in the Appendix ("App.") at App. 1a-13a. The unreported opinion of the United States District Court for the Southern District of Texas is reproduced at App. 14a-21a.

JURISDICTION

This case arises under the Copyright Act of 1976, 17 U.S.C. §§ 101 *et seq* (1982 & 1986 Supp. IV) (hereinafter the "Copyright Act"). Federal jurisdiction is founded upon 28 U.S.C. §§ 1331 and 1338(a). This Court has jurisdiction pursuant to 28 U.S.C. §§ 1254(1) and 2101(c).

STATUTES INVOLVED

Section 101 of the Copyright Act provides in pertinent part:

> As used in this title, the following terms and their variant forms mean the following:
>
> * * *
>
> "Pictorial, graphic, and sculptural works" include two dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, *maps*, globes, charts, technical drawings, diagrams, and models. * * *

17 U.S.C. § 101 (emphasis added).

Section 102 of the Copyright Act provides:

> (a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:
>
> * * *
>
> (5) pictorial, graphic and sculptural works;
>
> * * *

> (b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

17 U.S.C. § 102.

Section 103(a) of the Copyright Act provides in pertinent part:

> (a) The subject of copyright as specified by section 102 includes *compilations* . . .

17 U.S.C. § 103(a) (emphasis added).

Section 107 of the Copyright Act provides:

> [T]he fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified [in Section 106], for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—
>
> (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
>
> (2) the nature of the copyrighted work;
>
> (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
>
> (4) the effect of the use upon the potential market for or value of the copyrighted work.

17 U.S.C. § 107.

Section 502(a) of the Copyright Act provides:

> (a) Any court having jurisdiction of a civil action arising under this title may, subject to the provisions of section 1498 of title 28, grant temporary and final injunctions on such terms as it may deem reasonable to prevent or restrain infringement of a copyright.

17 U.S.C. § 502(a).

Rule 52(a) of the Federal Rules of Civil Procedure provides in pertinent part:

> Findings of fact . . . *shall not be set aside unless clearly erroneous*, and due regard shall be given to the opportunity of the trial court to judge the credibility of the witnesses.

Fed.R.Civ.P. 52(a) (emphasis added).

STATEMENT OF THE CASE

This case calls upon the Court to correct a decision of the U.S. Court of Appeals for the Fifth Circuit which negates copyright protection for maps through a novel application of the "merger doctrine," contrary to a long line of established authority going back to the first copyright act. In reaching its unprecedented finding, the Court of Appeals ignored the primary issue presented to it, namely, whether a presumption of irreparable harm may be recognized by the district court in considering the availability of preliminary injunctive relief under Section 502(a) of the Copyright Act, 17 U.S.C. § 502(a). There is a direct and acknowledged conflict of opinion among the circuits

on this issue; the Fifth Circuit is the only court which refuses to recognize the presumption.[1]

The Court of Appeals was able to reach the merger issue only by rendering independent findings of fact in violation of Rule 52(a) of the Federal Rules of Civil Procedure (Fed.R.Civ.P.) and in direct conflict with this Court's instructions in *Pullman-Standard v. Swint*, 456 U.S. 273 (1982), and *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844 (1982). In this manner the Fifth Circuit also ignored the other significant issue presented to it, *i.e.*, whether the copying of Petitioner's maps by Respondents for the purpose of obtaining regulatory approval for a competing proposal involving construction of a 1,000 mile natural gas pipeline constituted "fair use" under Section 107 of the Copyright Act, 17 U.S.C. § 107.

I. Statement of Facts

The copyrighted maps at issue[2] depict a proposed 1,000 mile natural gas pipeline extending from southwestern Wyoming to Bakersfield, California. Over a period of approximately two years, the pipeline route was developed and drawn in intricate detail by Petitioner's engineers and cartographers onto approximately 140 topographical maps obtained from the United States Geological Survey (USGS). It is undisputed that Petitioner developed these detailed

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[1] Prior to the Court of Appeals' ruling, Petitioner filed a Suggestion for Hearing *En Banc* in order to present the Fifth Circuit with an opportunity to reconsider its holding in *Plains Cotton Cooperative Association v. Goodpasture Computer Service, Inc.*, 807 F. 2d 1256 (5th Cir.), *cert. denied*, 484 U.S. 821 (1987). The Fifth Circuit in *Plains Cotton* rejected the prevailing view and held that, for purposes of determining the availability of preliminary injunctive relief in a case of copyright infringement, a presumption of irreparable harm is "not established" in the Fifth Circuit. *See* discussion below. The Court of Appeals summarily denied Petitioner's Suggestion.

[2] These maps are subject to U.S. Certificate of Copyright Registration No. VAu 145 000, issued by the Copyright Office on February 7, 1989 (reproduced at App. 23a).

1:24,000 scale "quad" maps by conducting "full, independent field work along every segment of the proposed route." 899 F.2d at 1460 (App. 3a). The costs incurred by Petitioner in creating these maps amounted to millions of dollars, including payroll, vehicle rentals, helicopter lease time, radio communication systems and geotechnical studies.

All of this activity occurred in the context of regulatory proceedings conducted by the Federal Energy Regulatory Commission (FERC). These proceedings involved applications by various parties, including Petitioner and Respondents, to construct and operate a natural gas pipeline serving the market in and around Kern County, California.

In October 1986, Petitioner submitted its original 1:24,000 scale "quad" maps of its proposed pipeline to the FERC in support of its application for regulatory approval, along with another set of larger scale 1:250,000 maps also prepared by Petitioner's draftsmen. Petitioner's large scale 1:250,000 maps, which are not at issue in this appeal, represented the approximate location of Petitioner's proposed route at that time. The highly detailed 1:24,000 maps, in contrast, depicted Petitioner's proposal for the actual placement of a 36-inch pipeline within that route.

Petitioner was the only party to conduct field investigations, environmental analysis and other survey work in connection with the placement of its proposed pipeline. Consequently, Petitioner's maps played a substantial role in the preparation of an Environmental Impact Statement ("EIS") pursuant to the National Environmental Policy Act, 42 U.S.C. §§ 4331 *et seq.* Petitioner's maps eventually became the basis for a mile-wide route which was analyzed by the California State Lands Commission (CSLC) and ultimately approved by the FERC. This mile-wide section became known as the "EIS corridor" or "approved route," and was depicted by a line drawn by the FERC's con-

tractor on a set of 1:250,000 scale maps that was published with the agency's EIS.

The District Court found that Petitioner's large scale 1:250,000 scale maps could not be copyrighted because, at that scale, they were equivalent merely to the approved route, or EIS corridor, and as such constituted only the idea of the route. Petitioner has not contested that finding. However, the District Court held that Petitioner's 1:24,000 scale maps *were* subject to copyright protection because they expressed only one of innumerable possible placements of a specific pipeline within the mile-wide approved corridor. This finding was reversed by the Court of Appeals.

The distinction between the large-scale 1:250,000 maps depicting the approximate location of the approved route, and Petitioner's intricate 1:24,000 scale maps expressing a proposal for placement of a 36-inch pipeline *within* the approved route, is crucial to an understanding of this case because it underlies the District Court's dispositive factual finding. The large scale 1:250,000 maps which were ultimately adopted by the FERC, by use of a single line extending from southwestern Wyoming to Bakersfield, California, depicted the mile-wide swath of the approved route. These maps defined the broad path which the FERC deemed to be environmentally acceptable; a pipeline falling outside this "EIS corridor" would be subject to further environmental study.[3] Any applicant was free to choose a pipeline route anywhere within the EIS corridor, and the 1:250,000 maps depicting the mile-wide approved route were available to all parties for that purpose.

In contrast, Petitioner's small scale 1:24,000 quad maps depicted in detail the proposed placement of a 36-inch pipeline within the mile-wide section which ultimately became FERC's approved route. These 1:24,000 scale maps

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[3] Memorandum and Order of Judge Hoyt, July 18, 1989, ¶ 13, p. 4.

reflected the skill, labor and associated expenses incurred by Petitioner's engineers and cartographers in the analysis and selection of Petitioner's exact path *within* the approved route. Access to the small-scale 1:24,000 quad maps was not necessary to other applicants in order to obtain regulatory approval, although such maps were available to all parties for purposes of analysis and verification. Respondents' right to *examine* Petitioner's maps for purposes of analysis and verification, as opposed to Respondents' right to *copy* them, is not challenged in this appeal.

Respondents, however, did more than merely examine the 1:24,000 maps for purposes of analysis and verification. The District Court found that Respondents *copied* the maps.[4] On April 4, 1988, Respondent's draftsmen visited the Albuquerque headquarters of the independent consultant which had custody of Petitioner's maps and, in the course of a ten-hour day, copied each of Petitioner's approximately 140 copyrighted 1:24,000 maps. Respondents copied Petitioner's maps to avoid the expense and labor required to develop their own maps after being informed by the FERC that the pipeline route depicted on the maps which Respondents had previously submitted lay outside the mile-wide EIS corridor. These facts are undisputed.

Respondents concede that they distributed the copied maps to the FERC, the CSLC, the independent consultant and other interested persons in support of Respondents' competing pipeline proposal. Respondents also admit that they exploited their copies of Petitioner's maps for their own competitive purposes in presentations to potential customers, environmental groups, developers, planners and other regulatory agencies interested in the project. The issue raised is whether the Copyright Act protects a map-

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[4] Memorandum and Order of Judge Hoyt, July 18, 1989), ¶¶ 10, 11, pp. 3-4 (App. 16a).

maker's original works of cartographic authorship from such unauthorized copying and commercial exploitation.

II. Proceedings Below

On March 20, 1989, Petitioner filed motions for a temporary restraining order and preliminary injunction, together with a complaint for damages and injunctive relief alleging copyright infringement and common law misappropriation. The District Court granted Petitioner's motion for a temporary restraining order on March 27, 1989 and impounded Respondents' infringing copies of Petitioner's maps.

The District Court conducted hearings on Petitioner's motion for preliminary injunction on May 9-12 and 26, 1989 and resolved all but two of numerous issues in Petitioner's favor, holding that:

(1) the 1:24,000 scale maps were subject to copyright protection;

(2) Petitioner was the owner of the copyrights in the maps;

(3) the copyrights in question were valid and subsisting; and

(4) Respondents copied the maps, enabling them to produce their own detailed maps which they supplied to the FERC, the Bureau of Land Management, the California State Lands Commission, the U.S. Forest Service, and other agencies which required a detailed depiction of Respondents' proposed pipeline route, during the process of Respondents' application to obtain a certificate of public convenience and necessity.

However, the District Court found that Petitioner failed to prove a threat of irreparable harm, and that Respondents' use of Petitioner's maps constituted "fair

use" under 17 U.S.C. § 107.[5] On July 18, 1989, the District Court issued a Memorandum and Order dissolving the temporary restraining order and denying Petitioner's request for a preliminary injunction.

Petitioner sought review of the District Court's denial of preliminary injunctive relief in an interlocutory appeal pursuant to 28 U.S.C. § 1292(a). In its appeal to the Fifth Circuit, Petitioner presented the two issues which formed the basis for the District Court's denial of preliminary injunctive relief: (1) whether the District Court erred in finding that Petitioner failed to establish irreparable injury as a prerequisite to preliminary injunctive relief; and (2) whether the District Court erred in holding that Respondents' copying of Petitioner's maps constituted "fair use."

In its reported opinion, the Fifth Circuit disregarded the issues presented in Petitioner's appeal and instead affirmed the District Court's denial of preliminary injunctive relief through an unprecedented application of the merger doctrine to preclude copyright protection for original works of cartography. This was a ground that the District Court had considered and rejected on the basis of the factual record. The Court of Appeals, with no regard to the "clearly erroneous" standard in Fed.R.Civ.P. 52(a), reversed the District Court's finding and held that recognition of copyright protection in the 1:24,000 maps would confer on Petitioner "a monopoly over the only approved pipeline route." 899 F.2d at 1465 (App. 12a). The Court of Appeals stated:

> To extend protection to the lines [on Petitioner's 1:24,000 maps] would be to grant [Petitioner] a *mo-*

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[5] Even so, the District Court stated that it was "of the opinion that . . . [Petitioner] may have suffered damages and may prevail at the time of trial on the merits. . ." Memorandum and Order at pp. 7-8 (App. 21a).

> *nopoly of the idea for locating a proposed pipeline in the chosen corridor*, a foreclosure of competition that Congress could not have intended to sanction through copyright law.

Id. at 1464 (App. 10a) (emphasis added). The Court of Appeals concluded:

> [Petitioner] may not invoke the Copyright Act to monopolize the proposed location for a pipeline.

Id. (App. 11a)

Petitioner brought this error to the Court of Appeals' attention in a Petition for Rehearing, which was summarily denied in an Order dated June 15, 1990 (reproduced at App. 22a). On August 8, 1990, the District Court granted a renewed motion to dismiss filed by Respondents and dismissed Petitioner's claims.

REASONS FOR GRANTING CERTIORARI

I. THE FIFTH CIRCUIT'S UNPRECEDENTED APPLICATION OF THE "MERGER" DOCTRINE NEGATES COPYRIGHT PROTECTION FOR ALL MAPS AND CONTRADICTS A LONG LINE OF AUTHORITIES GOING BACK TO THE FIRST COPYRIGHT ACT OF 1790.

The merger doctrine, which dates back to *Baker v. Selden*, 101 U.S. 99 (1879),[6] reflects the fact that some ideas admit of only a limited number of expressions. When there is essentially only one way to express an idea, the idea and its expression are inseparable or "merged" and copyright is no bar to copying that expression.

> The merger principle . . . is a variation of the idea/expression dichotomy . . . [W]hen the idea and the expression of the idea coincide, then the expression will not be protected in order to prevent creation of

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[6] *See also Mazer v. Stein*, 347 U.S. 201 (1954).

> a monopoly on the underlying "art." . . . [A]n expression will be found to be merged into the idea when "there are no or few other ways of expressing a particular idea."

Educational Testing Services v. Katzman, 793 F.2d 533, 539 (3d Cir. 1986), quoting *Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d 1240, 1253 (3d Cir. 1983), *cert. dism'd*, 464 U.S. 1033 (1984).

However, there is a category of copyrightable works uniquely unsuited to application of the merger doctrine: maps. Professor Robert Gorman, the leading writer on copyright in factual works, has observed that the map "is the quintessential fact work. Its purpose is to depict geographic fact with utmost accuracy and conformity to nature. If ever there were a literary or art form in which fancy is generally to be discouraged, and in which expression is dictated by fact, it is the map." Gorman, *Fact or Fancy? The Implications for Copyright*, 29 J. Copyright Soc'y USA 560, 564 (1982).

The Fifth Circuit has now issued a ruling which extends the merger doctrine in a manner which precludes copyright protection for maps in general. The appellate court's ruling is unprecedented, and its reliance on *Baker v. Selden* is in direct conflict with the decision in *Mazer v. Stein*, 347 U.S. 201 (1954), where this Court specifically discussed *Baker v. Selden* in explaining why the merger doctrine does *not* preclude copyright protection for maps:

> The distinction [between patents and copyrights] is illustrated in *Fred Fisher, Inc. v. Dillingham*, 298 F. 145, 151, when the court speaks of two men, each a perfectionist, independently making maps of the same territory. *Though the maps are identical, each may obtain the exclusive right to make copies of his own particular map*, and yet neither will infringe the other's copyright. Likewise a copyrighted directory is not

> infringed by a similar directory which is the product of independent work.

Mazer v. Stein, 347 U.S. at 217-18 (emphasis added). For the reasons discussed below, a writ of certiorari is necessary in this case to correct a serious error concerning an important issue of federal law.

A. Maps Prepared Through Independent Surveys And Direct Observations By Cartographers In The Field Have Always Been Subject To Copyright Protection.

Maps and charts have been copyrightable since 1790, being one of the original subjects of copyright under the first federal copyright law, which specified maps, charts and books as objects of protection. Act of May 31, 1790, 1st Cong., 2d Sess., Ch. 15, 1 Stat. 124. In 1839, Justice Story articulated the controlling principle:

> There is no foundation in law for the argument, that because the same sources of information are open to all persons, and by the exercise of their own industry and talents and skill, they could, from all these sources, have produced a similar work, one party may at second hand, without any exercise of industry, talents, or skill, borrow from another all the materials, which have been accumulated and combined together by him. *Take the case of a map* of a county, or of a state, or an empire; it is plain, that in proportion to the accuracy of every such map, must be its similarity to, or even its identity with, every other. *Now, suppose a person has bestowed his time and skill and attention, and made a large series of topographical surveys in order to perfect such a map* . . . It is clear, that notwithstanding this production, he cannot supersede the right of any other person to use the same means by similar surveys and labors to accomplish the same end. *But it is just as clear, that he has no right, without any such surveys and labors, to*

> *sit down and copy the whole of the map already produced by the skill and labors of the first party . . .*

Gray v. Russell, 10 F. Cas. 1035, 1037-38 (No. 5728) (C.C.D.Mass. 1839) (emphasis added).

Six years later, in *Emerson v. Davies*, 8 F. Cas. 615 (No. 4436) (C.C.D. Mass. 1845), Justice Story explained:

> A man has a right to the copy-right of a map of a state or country, which he has surveyed or caused to be compiled from existing materials, *at his own expense, or skill, or labor, or money.* Another man may publish another map of the same state or country, by using the like means or materials, and the like skill, labor and expense. But then he has no right to publish a map taken substantially and designedly from the map of the other person, without any such exercise of skill, or labor, or expense. *If he copies substantially from the map of the other, it is downright piracy*; although it is plain that both maps must, the more accurate they are, approach nearer in design and execution to each other.

8 F. Cas. at 619 (emphasis added). The same principle was stated again in 1872:

> The defendant, no doubt, had the right to go to the common source of information, and having ascertained those boundaries, to have drawn them upon its map, notwithstanding that in this respect it would have been precisely like complainant's map . . . But he had no right to avail himself of this very labor on the part of complainant in order to avoid it himself.

Farmer v. Calvert Lithographing Co., 8 F. Cas. 1022, 1026 (No. 4651) (C.C.E.D. Mich. 1872). *Accord*, *Blunt v. Patten*, F.Cas. No. 1580 (C.C.N.Y. 1828).

In all of the cases going back to the first copyright act of 1790, copyright protection has never been denied to

maps produced as the result of "original effort in exploring, surveying, making inquiries, and drafting the map solely on the basis of one's own investigations."[7] "The copyrightability of a cartographer's independent drawings of basic geographic boundary lines, even though they were ascertained from public domain sources, ha[s] long been settled on authority as well as principle.[8] Copyright protection has been consistently afforded to maps like those of Petitioner. *E.g.*, *County of Ventura v. Blackburn*, 362 F.2d 515 (9th Cir. 1966) (road and street data identifying owners and land parcels recorded on topographical maps obtained from U.S. government); *General Drafting Co. v. Andrews*, 37 F.2d 54 (2d Cir. 1930) (detailed information based on personal interviews and observations recorded on topographical maps obtained from U.S. Geological Survey); *see also United States v. Hamilton*, 583 F.2d 448 (9th Cir. 1978); *Sawyer v. Crowell Publishing Co.*, 142 F.2d 497 (2d Cir. 1944); *C.S. Hammond & Co. v. International College Globe, Inc.*, 210 F. Supp. 206 (S.D.N.Y. 1962); *Crocker v. General Drafting Co.*, 50 F. Supp. 634 (S.D. N.Y. 1943); *Newton v. Voris*, 364 F. Supp. 562 (D.Ore. 1973).

The Fifth Circuit's opinion radically alters the scope of copyright protection for maps. While the Fifth Circuit is not the first court to recognize the policy considerations against conferring a monopoly over the facts underlying the copyrighted expression,[9] the Fifth Circuit is the first

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[7] Gorman, *Copyright Protection for the Collection and Representation of Facts*, 76 Harv. L. Rev. 1569, 1572 (1963). "Originality" requires only that the work display "something irreducible, which is one man's alone," *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 250 (1903), not that the work be novel in comparison with the works of others. *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 103 (2d Cir. 1951).

[8] Whicher, *Originality, Cartography, and Copyright*, 38 N.Y.U.L. Rev. 280, 288 (1963).

[9] *See* Goldstein, *Copyright* (1990 ed.), § 2.14.1, p. 175. In fact, the

court to hold that such considerations negate *all* copyright protection where the map contains an original contribution based on direct observation.[10]

The Court of Appeals' unprecedented application of the merger doctrine to Petitioner's maps has far-reaching and negative implications for the copyright law, for virtually every map is "merged" with the idea it expresses.[11] The Supreme Court should grant a writ of certiorari to correct this serious error of law.

B. The Fifth Circuit's Opinion Upsets The Copyright Protection Historically Recognized For Compilations Of Data

Compilations of data such as those represented by the lines on Petitioner's 1:24,000 scale maps are independently subject to copyright protection under Section 103(a) of the Copyright Act, 17 U.S.C. § 103(a). Section 103(a) provides that "compilations" are copyrightable, subject to the lim-

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primary debate over maps in the copyright literature focuses on whether some courts have correctly applied a stricter standard for copyright in maps for this reason. Gorman, *Copyright Protection for the Collection and Representation of Facts*, 76 Harv. L. Rev. 1569, 1575 (1963). However, even under the most restrictive map decisions, copyright protection has *never* been denied "when the publisher of the map in question obtains originally some of [the] information by the sweat of his own brow." *Amsterdam v. Triangle Publications, Inc.*, 189 F.2d 104, 106 (3d Cir. 1951) (denying copyright protection where mapmaker made no independent field observations and provided no original contribution).

[10] *Compare Del Madera Properties v. Rhodes & Gardner, Inc.*, 820 F.2d 973 (9th Cir. 1987). The plaintiff in *Del Madera Properties* claimed that the defendant had infringed its copyright in a tentative map of a subdivision by developing the subdivision in accordance with the plaintiff's map. The court rejected the defendant's arguments that (1) the map was uncopyrightable because it was a government enactment subsumed under the general zoning and development laws and that (2) the government's approval of the tentative map constituted a land use decision benefitting all present and subsequent owners of the property.

[11] *See* Gorman, *Fact or Fancy? The Implications for Copyright*, 29 J. Copyright Soc'y USA 560, 564 (1982).

itation in § 103(b) that the copyright in a compilation "extends only to the material contributed by the author of such work, as distinguished from any preexisting material employed in such work." *Rockford Map Publishers, Inc. v. Directory Service Co.*, 768 F.2d 145 (7th Cir.), *cert. denied*, 474 U.S. 1061 (1986). The close relationship in this respect between maps and compilations of data, including directories, was noted by this Court in *Mazer v. Stein*, 347 U.S. at 18.

The contribution of a compilation of data lies in its presentation, not in the facts themselves. The collector may change the form of information and so make it more accessible, or he may change the organization and so make the data more understandable. Thus a catalog of names and addresses is copyrightable, *Schroeder v. William Morrow & Co.*, 566 F.2d 3, 5 (7th Cir. 1977), as is a directory of trade symbols, *Jewelers' Circular Pub. Co. v. Keystone Pub. Co.*, 274 F. 932 (S.D.N.Y. 1921) (L. Hand, J.), *aff'd*, 281 F. 83 (2d Cir.), *cert. denied*, 259 U.S. 581 (1922), and a compilation of logarithms, *Edwards & Deutsch Lithographing Co. v. Boorman*, 15 F.2d 35 (7th Cir. 1926). Petitioner's maps represent a similar compilation of data consisting of points on a map.

In *Rockford Map Publishers*, the court held that the plaintiff's map showing the location, size, and ownership of parcels of land in a county, was subject to valid copyright protection as a compilation of data. The court there stated:

> [Defendant] may make all the plat maps it wants; everyone is free to repeat the facts contained in the deeds. *But it may not use* [*plaintiff's*] *work as the template.*

768 F.2d at 149 (emphasis added). The court in *Rockford Map Publishers* recognized the defendant's right to *examine* the plaintiff's data but held that the defendants could not engage in wholesale copying, stating:

> All concede, as Learned Hand said in *Jewelers Circular*, 274 F. at 935, that "a second compiler may check back his independent work upon the original compilation." *The right to "check back" does not imply a right to start with the copyrighted work. Everyone must do the same basic work, the same "industrious collection." "A subsequent compiler is bound to set about doing for himself what the first compiler has done." Kelly v. Morris*, [1886] 1 Eq. 697, 701 (Wood, V.C.). The second compiler must assemble the material as if there had never been a first compilation; only then may the second compiler use the first as a check on error."

Id. (emphasis added).

The *Rockford Map Publishers* case illustrates the fact that copyright protection in a compilation of data does *not* present a threat of monopoly over the underlying facts. As stated by the leading scholar in this area:

> [T]he grant of a monopoly on the compiler's particular chart . . . does not bar others from making the same calculations; it merely prevents others from copying directly. The monopoly is therefore of little prejudice to the public interest. *The argument is precisely the same in map cases.*

Gorman, *Copyright Protection for the Collection and Representation of Facts*, 76 Harv. L. Rev. 1569, 1575 (1963) (emphasis added). "What the copyright monopoly here protects is . . . the effort, time, expense, and . . . the skill employed" in creating the map. *Id.* at 1570.

The Court of Appeals in the present case should have (1) recognized that Petitioner's 1:24,000 scale maps were validly copyrighted and (2) proceeded to determine whether Respondents' copying of the maps and commercial exploitation of the copies was an infringement. Instead the Court of Appeals independently and erroneously found that

recognition of copyright protection for Petitioner's maps would confer a monopoly on Petitioner over the "only approved pipeline route." 899 F.2d at 1464-65. As discussed below, the Court of Appeals directly contradicted the District Court in reaching this finding with no regard to its scope of appellate review and in direct violation of this Court's mandate in *Pullman-Standard v. Swint*, 456 U.S. 273 (1982) and *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844 (1982).

C. The Court of Appeals Ignored This Court's Instructions in *Pullman Standard* and *Inwood Laboratories* in Reversing the District Court's Factual Findings in Respect to the Validity of Petitioner's Copyrights.

Although the Fifth Circuit affirmed the District Court's denial of preliminary injunctive relief, it reversed the lower court's factual determination that Petitioner's 1:24,000 scale maps were subject to a valid copyright. The District Court found that such maps were validly copyrighted because they did *not* represent the only available expression of a 36-inch pipeline within the mile-wide approved corridor. The Court of Appeals disagreed, stating:

> To extend copyright protection to the quad maps would grant [Petitioner] a monopoly over the only approved pipeline route.

Id. at 1464-65. In reaching this finding the Court of Appeals cited the conclusion of an administrative law judge in the proceedings before the FERC that the "Southern California . . . market could support only one pipeline." *Id.* at 1464. However, the Court of Appeals overlooked the District Court's finding that *any* party was free to place a pipeline anywhere within the mile-wide corridor and did not require the use of Petitioner's 1:24,000 maps to do so.[12]

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[12] The District Court's Memorandum and Order dated July 17, 1989

In an effort to distinguish the single case most directly on point, *WPOW, Inc. v. MRLJ Enterprises*, 584 F. Supp. 132 (D.D.C. 1984),[13] the Court of Appeals observed that in *WPOW* the information in the copyrighted work had been chosen from "an almost infinite number" of alternatives. The Court of Appeals then stated:

> In contrast, the Commission [FERC] in the instant case at the time the copying occurred had approved *only one EIS corridor through which a pipeline could be built* without additional time-consuming and costly environmental study.

Id. (emphasis added). In this manner the Court of Appeals overturned the District Court's finding that *within* the EIS corridor it would have been equally possible to select " 'an almost infinite number' of alternatives" without copying Petitioner's 1:24,000 scale maps. Thus, the Court of Appeals erroneously equated the mile-wide EIS corridor with Petitioner's placement of its proposed pipeline in that corridor, as expressed on the 1:24,000 scale maps.

The Court of Appeals never acknowledged that it was reversing a dispositive factual finding of the District Court and never considered whether the District Court's finding was "clearly erroneous" within the meaning of Fed.R.Civ.P. 52(a). Rule 52(a) provides in pertinent part:

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contained a factual finding that *any* pipeline route located within the mile-wide EIS corridor was subject to approval by the FERC without the need for any further environmental analysis. *See* July 17, 1989 Memorandum and Order ¶¶ 8, 9, 12, 16, and 17 (App. 16a-17a).

[13] In *WPOW* the plaintiff, an applicant before the Federal Communications Commission, submitted a copyrighted engineering report to the agency which the defendant copied and submitted in support of a subsequent competing application. The District Court in *WPOW* found copyright infringement and held that the author was entitled to a preliminary injunction impounding "all of defendants' materials which infringe plaintiff's engineering report and antenna design." 584 F. Supp. at 139.

> Findings of fact . . . *shall not be set aside unless clearly erroneous*, and due regard shall be given to the opportunity of the trial court to judge the credibility of the witnesses.

Fed.R.Civ.P. 52(a) (emphasis added).[14]

This Court has specifically instructed the Fifth Circuit to observe the requirements of Fed.R.Civ.P. 52(a) and refrain from vacating the factual findings of a district court in the absence of a specific determination that those findings are clearly erroneous. In reversing a decision of the Fifth Circuit which purported to set aside a finding of "ultimate fact" without applying the "clearly erroneous" standard set forth in Rule 52(a), this Court stated:

> Rule 52(a) broadly requires that findings of fact not be set aside unless clearly erroneous. It does not make exceptions or purport to exclude certain categories of factual findings from the obligation of a court of appeals to accept a district court's finding unless clearly erroneous. It does not divide facts into categories; in particular, it does not divide findings of fact into those that deal with "ultimate " and those that deal with "subsidiary" facts.

Pullman-Standard v. Swint, 456 U.S. 273, 287 (1982). In a companion case the Court stated further:

> An appellate court cannot substitute its interpretation of the evidence for that of the trial court simply because the reviewing court "might give the facts another construction, resolve the ambiguities differently, and find a more sinister cast to actions which the District Court apparently deemed innocent."

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[14] Application of the "clearly erroneous" rule to copyright cases has historically been recognized. *See Sawyer v. Crowell Publishing Co.*, 142 F.2d 497, 499 (2d Cir. 1944).

Inwood Laboratories, Inc. v. Ives Laboratories, Inc., 456 U.S. 844, 855 (1982), quoting *United States v. Real Estate Boards*, 339 U.S. 485, 495 (1950).

The record in this case contains no support for the Fifth Circuit's factual finding that Petitioner has attempted to claim an exclusive right of appropriation over the entire mile-wide corridor within which its proposed 36-inch pipeline is to be located. The record clearly demonstrates to the contrary, and the District Court correctly found, that innumerable possibilities existed for placement of a specific pipeline within the mile-wide approved route. Petitioner has never claimed an exclusive right to any proposed route and has repeatedly acknowledged that Respondents were free to select the *exact* pipeline location depicted in Petitioner's 1:24,000 scale maps so long as Respondents performed their own survey work, created their own maps and did not copy Petitioner's maps.

The Fifth Circuit has now rendered a reported decision which negates the copyright protection historically afforded to maps and has fundamentally violated Fed.R.Civ.P. 52(a) in the process. As discussed below, the Court of Appeals reached its result in a vacuum because it refused to address the primary issue squarely presented to it, namely, whether a presumption of irreparable harm may be recognized by a district court for purposes of determining the availability of preliminary injunctive relief pursuant to Section 502(a) of the Copyright Act, 17 U.S.C. § 502(a).

II. THERE IS A DIRECT AND ACKNOWLEDGED CONFLICT OF AUTHORITY BETWEEN THE FIFTH CIRCUIT AND EVERY OTHER CIRCUIT TO CONSIDER THE AVAILABILITY OF A PRESUMPTION OF IRREPARABLE HARM UNDER SECTION 502(a) OF THE COPYRIGHT ACT.

One of the two issues squarely presented by Petitioner in its appeal to the Fifth Circuit was whether a district

court may recognize a presumption of irreparable harm for purposes of determining whether to issue a preliminary injunction pursuant to Section 502(a) of the Copyright Act. There is a direct and acknowledged conflict of authority among the Circuits on this question. In *Plains Cotton Cooperative Association v. Goodpasture Computer Service, Inc.*, 807 F. 2d 1256 (5th Cir.), *cert. denied*, 484 U.S. 821 (1987), the Fifth Circuit rejected the view of every other Circuit to consider the issue and held that, for purposes of determining the availability of preliminary injunctive relief in a case of copyright infringement, a presumption of irreparable harm is "not established in this Circuit." 807 F.2d at 1261, citing *Apple Barrel Productions*, 730 F.2d 384, 390 (5th Cir. 1984); *see also Southern Monorail Co. v. Robbins & Myers, Inc.*, 666 F.2d 185, 186 (5th Cir. 1982). Because the *Plains Cotton* holding conflicts with the law in every other Circuit to consider the issue, Petitioner urged the Court of Appeals to reconsider that holding as a predicate for considering the instant appeal. The Fifth Circuit summarily denied Petitioner's suggestion.

Application of the presumption of irreparable harm is critical in the present case. The District Court found each of the factual elements necessary for preliminary injunctive relief under Section 502(a). The District Court found that (1) the maps in question were subject to a valid and subsisting copyright; (2) Petitioner owned the copyright; and (3) Respondents copied all of Petitioner's approximately 140 copyrighted maps for more than 450 miles of the pipeline route to advance Respondents' own competitive and commercial interests. This is all that Petitioner was statutorily required to prove.[15] Yet the District Court found

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[15] To prevail on a claim of copyright infringement, a plaintiff must prove (1) ownership of copyright and (2) copying by the alleged infringer. M. Nimmer, 3 *Nimmer on Copyright* § 13.01 (1980). The District Court in this case found that those elements were established.

that the evidence failed to establish a threat of irreparable harm.[16]

However, the damage resulting from copyright infringement is *inherently* irreparable because it lies in the author's loss of exclusive rights to the copyrighted work. "Unlike most property rights, the value of this interest is often fleeting." *Concrete Machinery Co. v. Classic Lawn Ornaments*, 843 F.2d 600, 611 (1st Cir. 1988). Consequently, this Court has recognized a presumption of irreparable harm in cases of commercial copyright infringement, stating:

> *Actual present harm need not be shown*; such a requirement would leave the copyright holder with no defense against predictable damage. *Nor is it necessary to show with certainty that future harm will result.* What is necessary is a showing by a preponderance of the evidence that some meaningful likelihood of future harm exists. *If the intended use is for commercial gain, that likelihood may be presumed.*

Sony Corporation of America v. Universal City Studios, Inc., 464 U.S. 417, 451 (1984) (emphasis added).

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[16] The evidence of irreparable harm presented by Petitioner to the District Court consisted primarily of testimony establishing a substantial loss of future economic opportunity. The Court of Appeals acknowledged that the "Southern California . . . market could support only one pipeline." 899 F.2d at 464. Petitioner's witnesses testified that Petitioner was facing a substantial threat that it would lose the opportunity to construct that pipeline as a result of Respondents' copyright infringement. Additionally, there was evidence that Respondents' copying gained them significant advantages, in communications and negotiations with landowners and potential customers, independent of regulatory approval from the FERC. Finally, there was testimony that Petitioner experienced a significant loss of investment as a result of Respondents' infringement. Accordingly, in its appeal to the Fifth Circuit Petitioner contested the lower court's finding that the evidence failed to establish irreparable harm.

In determining whether to issue preliminary relief under Section 502(a), every court to consider the issue except the Fifth Circuit has held that a threat of irreparable harm should be presumed where, as in the present case, a prima facie case of copyright infringement is established. *See* 3 Nimmer, *Nimmer on Copyright*, § 14.06[A], n. 10 (1989). The presumption has been recognized by the United States Courts of Appeals for the First,[17] Second,[18] Third,[19] Sixth,[20] Seventh,[21] Eighth[22] and Ninth[23] Circuits, as well as district courts in the Eleventh Circuit[24] and the District of Columbia Circuit.[25]

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[17] *Concrete Machinery Co., Inc. v. Classic Lawn Ornaments, Inc.*, 843 F.2d 600, 611-612 (1st Cir. 1988).

[18] *Rushton v. Vitale*, 218 F.2d 434, 436 (2d Cir. 1955); *Uneeda Doll Co. v. Goldgarb Novelty Co.*, 373 F.2d 851, 852 (2d Cir. 1967); *Meredith Corp. v. Harper & Row Publishers, Inc.*, 378 F. Supp. 686, 691 (S.D.N.Y.), *aff'd*, 500 F.2d 1221 (2d Cir. 1974); *Hasbro Bradley v. Sparkle Toys, Inc.*, 780 F.2d 189, 192 (2d Cir. 1985); *Video Trip Corp. v. Lightning Video, Inc.*, 866 F.2d 50, 51-52 (2d Cir. 1989).

[19] *Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d 1240, 1254 (3d Cir.), *cert. dism'd*, 464 U.S. 1033 (1984).

[20] *Forry, Inc. v. Neundorfer, Inc.*, 837 F.2d 259, 267 (6th Cir. 1988); *Worlds of Wonder, Inc. v. Vector Intercontinental, Inc.*, 653 F. Supp. 135, 140 (N.D.Ohio 1986).

[21] *Atari, Inc. v. North American Philips Consumer Electronics Corp.*, 672 F.2d 607, 620 (7th Cir. 1982), *cert. denied*, 459 U.S. 880 (1982); *Jackson v. MPI Home Video, Inc.*, 694 F. Supp. 483, 488 (N.D.Ill. 1988).

[22] *West Publishing Co. v. Mead Data Center, Inc.*, 799 F.2d 1219, 1229 (8th Cir.), *cert. denied*, 479 U.S. 1070 (1986); *National Football League v. McBee & Bruno's, Inc.*, 792 F.2d 726, 729 (8th Cir. 1986); *Hutchinson Telephone Co. v. Fronteer Directory Co. of Minnesota, Inc.*, 640 F. Supp. 386, 388-89 (D. Minn. 1986).

[23] *Apple Computer, Inc. v. Formula International, Inc.*, 725 F.2d 521, 525-26 (9th Cir. 1984); *Walt Disney Productions v. Air Pirates*, 345 F. Supp. 108, 110 (N.D.Cal. 1972).

[24] *Metro-Goldwyn-Mayer, Inc. v. Showcase Atlanta Coop. Prod., Inc.*, 479 F. Supp. 351 (N.D.Ga. 1979); *O'Neill Developments, Inc. v. Galen Kilburn, Inc.*, 524 F. Supp. 710 (N.D.Ga. 1981); *Original Appalachian*

The Fifth Circuit stands alone in its refusal to consider the availability of such a presumption. In *Plains Cotton Cooperative Association v. Goodpasture Computer Service, Inc.*, 807 F. 2d 1256, 1261 (5th Cir. 1987), the Fifth Circuit rejected the opportunity to adopt the prevailing view with the terse statement that the presumption is "not established in this Circuit." 807 F.2d at 1261. For this reason, Petitioner filed a Suggestion for Hearing *En Banc* in this case, urging the Court of Appeals to reconsider its holding in *Plains Cotton*, but Petitioner's suggestion was summarily rejected.

The Court of Appeals was squarely confronted in this case with an issue as to which there is a direct and acknowledged conflict between the Fifth Circuit and all of the other appellate courts to consider that issue. The Court of Appeals improperly avoided this issue by overturning the factual conclusions of the District Court on the merger issue with complete disregard for the standard of review set forth in Fed.R.Civ.P. 52(a). However, the appellate court's refusal to consider the issue represents a ruling on the merits to the litigants before the court. The federal appellate mechanism was seriously undermined in this case, and the Supreme Court should grant a writ of certiorari to rectify the serious error of law which resulted.

III. THE COURT OF APPEALS VIOLATED THIS COURT'S INSTRUCTIONS IN *STEWART* AND *HARPER & ROW* BY REFUSING TO CONSIDER WHETHER RESPONDENTS' COPYING AND COMMERCIAL EXPLOITATION OF PETITIONER'S MAPS CONSTITUTED "FAIR USE" UNDER THE FACTORS SET FORTH IN SECTION 107 OF THE COPYRIGHT ACT.

All of the foregoing leads to the second issue which was squarely presented to, but ignored by, the Court of Appeals

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Artworks, Inc. v. Topps Chewing Gum, Inc., 642 F. Supp. 1031, 231 USPQ 850 (N.D.Ga. 1986).

[25] *Belushi v. Woodward*, 598 F. Supp. 36 (D.D.C. 1984); *WPOW v. MRLJ Enterprises*, 584 F. Supp. 32, 37 (D.D.C. 1984).

in this case. That issue is whether Respondents' copying of Petitioner's copyrighted maps and exploiting the copied maps as the basis for a competing pipeline proposal submitted to the FERC for regulatory approval, was a "fair use" within the meaning of Section 107 of the Copyright Act, 17 U.S.C. § 107. The District Court, without considering any of the statutory criteria set forth in Section 107, held that Respondents' copying of Petitioner's maps constituted "fair use" under the "totality of the circumstances," citing *Key Maps, Inc. v. Pruitt*, 470 F. Supp. 33, 39 (S.D. Tex. 1978).[26]

The Copyright Act expressly identifies four factors which "*shall be*" considered in every fair use analysis: (1) the purpose and character of the use, including its commercial nature; (2) the nature of the copyrighted work; (3) the proportion that was taken; and (4) the economic impact of the taking. 17 U.S.C. §107. While these statutory factors are not the *only* factors which may be considered, this Court has stated that in determining whether fair use is established the district court "*must* consider" them. *Stewart v. Abend*, ___U.S. ___ , ___, 109 L.Ed.2d 184, 211 (1990) (emphasis added); *accord, Harper & Row Publishers, Inc. v. Nation Enterprises, Inc.*, 471 U.S. at 560.

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[26] The *Key Maps* dispute arose when a fire marshal copied and distributed a composite fire zone map produced by a county engineer who drew lines on the plaintiff's copyrighted thoroughfare map. The court found fair use by the fire marshal because the use was noncommercial, the use did not diminish potential sales of the copyrighted maps, and a strong public interest supported dissemination of the fire zone maps to fire departments because the copyright proprietor had delayed supplying needed maps to the fire marshal's office after repeated requests. In contrast to *Key Maps*, Respondents' copying of Petitioner's 1:24,000 scale maps was purely commercial and had a substantial adverse effect on Petitioner's opportunity to market and ultimately build its proposed pipeline. No public interest such as fire safety justified Respondents' copying. *Key Maps* is clearly distinguishable from this case and, in any event, has been superseded by this Court's decisions in *Harper & Row* and *Stewart*, discussed below.

The District Court failed to consider or even mention the statutory factors and made no reference to the controlling law. Instead the District Court found fair use by determining that (1) Respondents' purported intent to copy only the EIS corridor rather than particular maps was permissible because the route itself was not subject to protection; and that (2) Respondents had no notice of Petitioner's copyright claims. Memorandum and Order at p. 7. The Court of Appeals avoided consideration of these factors by reversing the District Court's finding and by holding that Petitioner's 1:24,000 maps were not copyrightable.

The District Court's ruling on fair use was the single substantive issue presented to the Fifth Circuit on appeal. The appellate court, therefore, under *Stewart* and *Harper & Row*, was required to consider the four statutory factors set forth in Section 107 of the Copyright Act. Since the District Court found facts sufficient to evaluate each of the statutory factors, this Court " 'need not remand for further fact-finding . . . [but] may conclude as a matter of law that [the challenged use] do[es] not qualify as a fair use of the copyrighted work.' " *Harper & Row*, 471 U.S. at 560, quoting *Pacific & Southern Co. v. Duncan*, 744 F.2d 1490, 1495 (11th Cir. 1984).

The "fair use" issue in this case is an important question of federal law, for the recognition of copyright protection in Petitioner's 1:24,000 maps would come to nothing if the lower court's finding on fair use were permitted to stand. Moreover, the District Court's application of the fair use defense based on "the totality of the circumstances," without more, removes any criteria for application of the defense and renders the doctrine exceedingly dangerous.

The fair use issue raised in this case is far reaching, for the public has a decided interest in the enforcement of copyright protection on behalf of one who is willing to invest his time and capital in a project of this scale. By

threatening to negate copyright protection for maps generally, the Court of Appeals' opinion raises an issue of exceptional importance in the natural gas industry which will certainly arise again unless resolved at this time.

If a copyright infringer is permitted to appropriate the maps or other works of authorship belonging to another party in connection with a competing proposal before the FERC or any other agency, parties who go before such agencies will not be willing to be the first to file or proceed because of the threat that their efforts will be exploited by a late-comer. As stated by a district court in enforcing the copyright of an applicant before an administrative agency under substantially identical facts:

> As for the public interest, it . . . lies with the protection of the copyright laws. . . . Defendants argue that the public interest will be harmed by the removal of an otherwise qualified applicant in the pending proceedings . . . But defendants can hardly be deemed "qualified" on the basis of an application which is the copy of another applicant's work. Moreover, the public benefits they seek may not be obtained at the expense of the Copyright Act.

WPOW Inc. v. MRLJ Enterprises, 584 F. Supp. at 138-139. Similar considerations affecting the public interest justify a writ of certiorari in the present case.

CONCLUSION

This case presents larger issues than the aggravated injustice suffered by Petitioner as a result of the appellate court's capricious disposition of its appeal. In an effort to avoid confronting the issue of irreparable harm in respect to which it stands in direct conflict with every other Circuit to consider the issue, the Fifth Circuit extended the merger doctrine far beyond its historical application in a way which threatens the entire field of cartography by

undermining the copyright protection afforded to maps since the first copyright act of 1790. In doing so, the Court of Appeals reversed the factual determinations of the District Court with no regard to the "clearly erroneous" standard set forth in Fed.R.Civ.P. 52(a) or the instructions of this Court in *Pullman-Standard* and *Inwood Laboratories*.

This Court should grant a writ of certiorari to correct the Fifth Circuit's errors on these important questions of federal law. The Court should also resolve the issue of fair use in order to make it clear that a defendant who copies and commercially exploits a series of maps created by a plaintiff as the result of independent field surveys, direct observation and millions of dollars in expense, is not immune from an infringement action under the "fair use" provisions of the U.S. copyright law.

Respectfully submitted,

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APPENDIX

UNITED STATES COURT OF APPEALS,
FIFTH CIRCUIT

May 8, 1990

No. 89-2831

KERN RIVER GAS TRANSMISSION CO.,
Plaintiff-Appellant,

v.

THE COASTAL CORPORATION, *et al.*,
Defendants-Appellees.

Rehearing Denied June 15, 1990

J. Timothy Hobbs, Vincent M. Amberly, David C. Gryce, Mason, Fenwick, Lawrence, Washington, D.C., Alan H. Gordon, William D. Raman, Arnold, White, & Durkee, Houston, Tex., for plaintiff-appellant.

Robin C. Gibbs, Robert N. Brailas, Gibbs & Ratliff, Houston, Tex., for defendants-appellees.

Appeal from the United States District Court for the Southern District of Texas.

Before CLARK, Chief Judge, THORNBERRY and JONES, Circuit Judges.

CLARK, Chief Judge:

Kern River Gas Transmission Company ("Kern River") brings an interlocutory appeal from the district court's denial of a preliminary injunction against Wyoming-California Pipeline Company ("Wy-Cal") under section 502(a) of the Copyright Act of 1976 (the "Act"), 17 U.S.C. §

502(a). By means of lines added to government survey maps, Kern River depicted the proposed route of a natural gas pipeline and submitted the maps to the Federal Energy Regulatory Commission (the "Commission") and other federal and state regulatory agencies in support of its application for authority to build the pipeline. Wy-Cal copied portions of the maps and submitted the copies to the Commission and other agencies in furtherance of its own application for authority to build a pipeline in the same corridor. The district court denied preliminary injunctive relief, holding that the proof did not establish the existence of a substantial threat of irreparable harm to Kern River, and that it showed Wy-Cal's use of the maps was fair use within the meaning of section 107 of the Act. Finding the maps at issue are not copyrightable under the Act, we affirm.

In the mid-1980s Kern River was engaged in intense competition with Mojave Pipeline Company for Commission approval to construct an interstate pipeline to supply natural gas to areas in and around Kern County, California. A large new market for natural gas had developed there among producers of heavy oil who burned gas to produce steam used in enhanced oil recovery. Kern River applied in 1985 to the Commission for a certificate of public convenience and necessity to construct a pipeline from southwestern Wyoming through Utah and Nevada to southern California. In May 1986 the Commission consolidated Kern River's application with that of Mojave, which had proposed to serve the southern California market by a different route, and ordered an administrative law judge to hold comparative evidentiary hearings. Among other findings, the ALJ predicted that the enhanced oil recovery market in southern California would be unable to support more than one interstate pipeline. *Public Utilities Comm'n v. FERC*, 900 F.2d 269, 283 (D.C.Cir. 1990).

In the course of preparing data requested by the Commission and other state and federal regulatory agencies,

Kern River drafted and submitted to the Commission several sets of maps depicting its entire proposed route and variations. Kern River submitted two sets of maps in October 1986, one set being on the scale of 1:250,000 (the "large-scale" maps), and the other at 1:24,000 (the "quad" maps). The quad maps are the focus of the copyright controversy here. They consisted of lines and mile markings drawn by Kern River on topographical maps published by the United States Geological Survey. Kern River developed the maps by conducting full, independent field work along every segment of the proposed route. Copies of Kern River's quad maps and the maps of its competitors were supplied to the Chambers Group, an environmental consultant under contract with the Commission and the California State Lands Commission to draft an environmental impact statement (EIS) describing and evaluating the pipeline construction and operation along the proposed route. Various other state and federal agencies as well as interested private parties received copies of the maps. Once submitted to the Commission, copies of the maps were available to all competitors who wished to study them.

In January 1987, the Chambers Group published a draft EIS. The document depicted among other things a mile-wide corridor running the length of Kern River's proposed route, as well as two variations proposed by Kern River known as the Wasatch and North Las Vegas Variations. The Commission's staff approved the EIS in December 1987. Staff approval was significant because any proposed pipeline constructed within the mile-wide corridor would require no further environmental study, whereas any route falling outside the corridor would be subject to further inquiry.

Wy-Cal applied to the Commission in August 1987 for a nonexclusive "Optional Expedited Certificate" pursuant to 18 C.F.R. Part 157, Subpart E. It proposed to adopt a 450-mile segment and other portions of Kern River's route. Wy-Cal drafted its own set of 1:250,000 maps in

support of its application and submitted them to the appropriate agencies. In February 1988 the Commission served a data request on Wy-Cal asking for quad maps for fifty-two miles of Wy-Cal's route in Wyoming and Nevada that were not common to any of the corridors approved in the EIS Wy-Cal complied and also created quad maps depicting its entire route at the of the California State Lands Commission. Wy-Cal prepared all of these quad maps without reference to or use of any Kern River map. The Commission denied a motion to consolidate Wy-Cal's application with these of Kern River and Mojave.

In March 1988, after delivery of the requested maps to the Commission and the California State Lands Commission, the Chambers group notified Wy-Cal that the line drawn on their maps indicated Wy-Cal's proposed route still deviated from the EIS corridor in certain locations. Chambers permitted draftsmen employed by Colorado Interstate Gas Co., an affiliate of Wy-Cal and one of its codefendants below, to come to Chambers' Albuquerque, New Mexico headquarters to ascertain the exact location of the center line of the EIS corridor, and to plot that line onto their own maps. During the draftsmen's visit, Chambers Group personnel provided them with reduced-scale copies of Kern River's quad maps. The draftsmen copied the center line for the entire EIS-approved route as depicted on Kern River's quad maps. None of the maps contained a copyright notice and Wy-Cal had no notice of any copyright claim until Kern River brought this action in the district court. Kern River registered the quad maps with the Copyright Office in February 1988 when it determined that Wy-Cal had copied them.

The Commission issued a final certificate of public convenience and necessity to Wy-Cal in March 1989. Kern River then brought this action against Wy-Cal for copyright infringement and misappropriation. In Count One of its complaint, Kern River asserted that all of the maps it

had created and submitted to the Commission were copyrightable material and had been copied by Wy-Cal, causing Kern River "extreme damage." Kern River argued essentially that by copying and using the maps, which were created at great expense to Kern River, Wy-Cal obtained an expedited certificate enabling them to commence construction and sign customers that would have done business with Kern River. In addition to praying for damages, Kern River asked the court to impound the maps and Wy-Cal's certificate of public convenience and necessity and to enjoin Wy-Cal using from the maps for any purpose. In Count II, Kern River claimed that by "adopting" the Kern River Route, Wy-Cal had committed common-law misappropriation, gaining an unfair advantage in the race for Commission approval, rate-setting and solicitation of customers. The misappropriation count is not involved in this appeal.

Simultaneously with the filing of the complaint, Kern River moved for a temporary restraining order (TRO) under the Copyright Act to impound the copied maps and to enjoin Wy-Cal from using them for any purpose. The court granted the TRO. The court then held a hearing on Kern River's motion for a preliminary injunction after which it dissolved the TRO and denied the preliminary injunction. The court held that the large-scale maps represented the idea of the pipeline route and that the idea was inseparable from its expression; therefore these maps were not copyrightable. The court found, however, that the quad maps were copyrightable and that Wy-Cal had copied them. The court also found that Wy-Cal had copied Kern River's maps in April of 1989; thus Kern River presented no evidence showing that the copying influenced the Commission's decision to grant Wy-Cal its certificate in March 1989. The court further determined that Kern River could suffer no harm unless it was required to alter its proposed route, thereby requiring additional EIS work and Commission approval, and unless Kern River was is-

sued a certificate of public convenience and necessity under which it could commence construction. Thus, the court held Kern River had failed to prove a substantial threat of irreparable harm. Additionally, the court held that considering the "totality of the circumstances" Wy-Cal's use of the maps was fair use within the meaning of section 107 of the Act because Wy-Cal intended only to copy or adopt the Kern River route.

In December 1989, claiming there existed an irreconcilable conflict between our decision in *Plains Cotton Cooperative Ass'n v. Goodpasture Computer Service, Inc.*, 807 F.2d 1256 (5th Cir. 1987), and the decision of the Supreme Court of the United States in *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 104 S.Ct. 774, 78 L.Ed.2d 574 (1984), Kern River filed a request in this court suggesting that we hear the appeal en banc in the first instance. We denied this extraordinary request.

In January 1990 the Commission granted Kern River a certificate of public convenience and necessity.

II

Kern River points out that the district court erred in finding no evidence connecting Wy-Cal's copying and the Commission's grant of a certificate to Wy-Cal, it being undisputed that Wy-Cal copied the maps in April of 1988, not 1989. Kern River also argues that under *Sony*, a court must presume the existence of a substantial threat of irreparable harm if it finds that copyrighted material has been copied. Kern River therefore urges that the district court erred in not presuming the existence of a threat of irreparable harm once it found that Wy-Cal had copied the quad maps. Finally, Kern River contends that the district court erred in finding fair use.

III

Spirited competition among several pipeline companies to serve the burgeoning demand for natural gas among

heavy oil producers conducting enhanced recovery in southern California drives the controversies between these pipelines. Their real battle is over which of them will serve this market. The merits of whether the Commission properly granted Wy-Cal its Optional Expedited Certificate and whether the Commission should have consolidated the applications of Wy-Cal, Kern River, and Mojave and required them to go head-to-head for the right of one to serve, have been decided by the United States Court of Appeals for the District of Columbia Circuit. The court affirmed the Commission's decision in all respects. *Public Utilities Comm'n, supra.* This copyright claim is no more than a harassing skirmish by Kern River against Wy-Cal in the larger fight for domination of this southern California market. We express no opinion to any issue that has been decided by or may later be presented to our sister circuit in that litigation.

The law controlling the issues raised here is well settled. A preliminary injunction may be granted under section 502 of the Copyright Act if the plaintiff establishes each of the following four factors: (1) a substantial likelihood that the plaintiff will succeed on the merits; (2) a substantial threat that the denial of the injunction will result in irreparable harm to the plaintiff; (3) the threatened injury to the plaintiff outweighs any damage that the injunction may cause to opposing parties; and (4) the injunction will not disserve the public interest. *Allied Mktg. Group, Inc. v. CD Mktg. Inc.*, 878 F.2d 806, 809 (5th Cir. 1989); *Apple Barrel Prod., Inc. v. Beard*, 730 F.2d 384, 386 (5th Cir. 1984). The preliminary injunction is an extraordinary remedy and will be granted only if the movant has clearly carried the burden as to all four of the elements. *Allied Mktg.*, 878 F.2d at 809; *Apple Barrel*, 730 F.2d at 389.

The decision to grant an injunction is within the sound discretion of the trial court. We may reverse only if the trial court has abused its discretion. *Allied Marketing*, 878 F.2d at 809. The district court's determinations as to each

of the elements required for a preliminary injunction are mixed questions of fact and law, the facts of which we leave undisturbed unless clearly erroneous. *Apple Barrel*, 730 F.2d at 386. The conclusions of law are subject to broad, de novo review. *Id.*

The first issue for our consideration is whether Kern River will likely succeed on the merits. To state a prima facie case of copyright infringement, the plaintiff must prove ownership of copyrighted material and copying of that mated by defendant. *Allied Marketing*, 978 F.2d 830; *Apple Barrel*, 730 F.2d at 387. "Ownership" is proved by establishing originality and copyrightability of the matter and compliance with statutory formalities. *Id.* at 810-11; *Apple Barrel*, 730 F.2d at 387. "Copying" may be shown by establishing that the defendant had access to the copyrighted material and that the defendant's work is substantially similar to the plaintiff's. *Id.* at 811.

The district court found that Kern River had created the lines locating its proposed pipeline route and properly registered the resulting quad maps, that the maps were copyrightable and that Wy-Cal had copied them. We agree that Kern River drafted the lines and properly registered the maps incorporating them, albeit after Wy-Cal copied the maps. However, the quad maps depicting the route are not subject to protection under the Copyright Act.

A

The Copyright Act reflects a tension created by Congress in balancing divergent public policies. Section 102(a), on one hand, provides in pertinent part that

> Copyright protection subsists . . . in original works of authorship fixed in any tangible medium of expression . . . from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

(5) pictorial, graphic, and sculptural works. . . .

17 U.S.C. § 102(a). Maps are included in the category of "pictorial, graphic, and sculptural works." Id. § 101. Section 102(b), on the other hand, provides that

> In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, *regardless of the form in which it is described, explained, illustrated, or embodied in such work.*

Id. § 102(b) (emphasis supplied). Thus, protection is extended to an expression of an idea fixed in a tangible form, but not to the idea itself regardless of the form in which it is fixed. In drawing this fundamental distinction, Congress balanced the competing concerns of providing incentive to authors to create and of fostering competition in such creativity. *Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d 1240, 1253 (3d Cir.1983) (citing *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971)); *Sid & Marty Krofft Television v. McDonald's Corp.*, 562 F.2d 1157, 1163 (9th Cir. 1977).

Courts have often found it difficult to draw the line between an idea and its expression. In his oft-cited "abstractions test," Judge Learned Hand in an infringement action between a playwright and an allegedly infringing movie studio explained that the difference between an idea an its expression is often a matter of degree:

> Upon any work, and especially upon a play, a great number of patterns of increasing generality will fit equally well, as more and more of the incident is left out. The last may, perhaps, be no more than the most general statement of what the play is about, and at times might consist only of its title; but there is a point in this series of abstractions where they are no longer protected, since otherwise the playwright could prevent the use of his "ideas," to which, apart from

> their expression, his property is never extended. Nobody has ever been able to fix that boundary, and nobody ever can.

Nichols v. Universal Pictures Corp., 45 F.2d 119, 121 (2d Cir. 1930) (citations omitted). "The guiding consideration in drawing the line [between an idea and its expression] is the preservation of the balance between competition and protection reflected in the patent and copyright laws." *Kalpakian*, 446 F.2d at 742.

The doctrine of "merger" developed in an effort to deal with this difficulty in locating the precise boundary between idea and expression. The doctrine holds that when the expression of an idea is inseparable from the idea itself, the expression and idea merge. "When the 'idea' and its 'expression' are thus inseparable, copying the 'expression' will not be barred, since protecting the 'expression' in such circumstances would confer a monopoly of the 'idea' upon the copyright owner free of the conditions and limitations imposed by the patent law." *Id.* (citing *Baker v. Selden*, 101 U.S. 99, 109, 25 L.Ed. 841 (1880)).

Thus, the district court held that the idea of the location of the pipeline and its expression embodied in the 1:250,000 maps are inseparable and not subject to protection. We agree. The idea of the proposed location of a prospective pipeline is not copyrightable. The 1:250,000 maps consisted of lines representing the proposed location of the pipeline drawn on maps sold to the general public. Such map markings are certainly the only effective way to convey the idea of the proposed location of a pipeline across 1,000 miles of terrain. To extend protection to the lines would be to grant Kern River a monopoly of the idea for locating a proposed pipeline in the chosen corridor, a foreclosure of competition that Congress could not have intended to sanction through copyright law, especially given the ALJ's finding in the Mojave/Kern River proceedings that the southern California enhanced oil recovery market could

support only one pipeline. The quad maps, drawn on a scale of 1:24,000, do not differ from the larger-scale maps to such a degree that copyright protection should attach. They also consist of lines representing the proposed location of a pipeline on standard reference, publicly available maps. Only the scale differs. And, just as with the 1:250,000 maps, the lines Kern River created express in the only effective manner the idea of the pipeline's location. Kern River's principal planning engineer testified that he could think of no other way to portray the idea of the pipeline's proposed location. The Commission's environmental approval of the route proposed by Kern River was neither private nor exclusive. Rather, it extended similar environmental approval to any applicant otherwise qualified to build a pipeline within the approved corridor. Just as with the 1:250,000 maps, Kern River may not invoke the Copyright Act to monopolize this proposed location for a pipeline.

The district court did find that Kern River conducted expensive and detailed field work to acquire the information needed to formulate mile-by-mile the precise location of their pipeline. Clearly, the consequent placement of locating lines on the 1:24,000 maps met the originality requirement of the Act. The problem for the copyrightability of the resulting maps however, is not a lack of originality, but rather that the maps created express in the only effective way the idea of the location of the pipeline.

Kern River urges that the reasoning employed in *WPOW, Inc. v. MRLJ Enterprises*, 584 F. Supp. 132 (D.D.C.1984) should control this case. We disagree. In *WPOW*, the plaintiff applied to the Federal Communications Commission to change its city of license and to build a transmitting antenna near the new city. 584 F. Supp. at 134. Included in its application was a detailed engineering report containing site coordinates, daytime and nighttime operating power, number of towers, tower

height, tower line bearing, tower spacing, tower current ratios, and transmission pattern shape and size. *Id.* & n. 5. After the plaintiff had submitted its application, the defendant submitted a competing application containing an engineering report identical to the plaintiffs in several particulars. *Id.*

The plaintiff brought an action for infringement. The court did not analyze whether the engineering report was copyrightable. Instead, it focused its analysis on whether the defendant's use was fair under 17 U.S.C. § 107. The *WPOW* court had no need to analyze whether merger of idea and expression occurred. In addition to proposing the location of the tower, the copyrighted report described numerous variable and detailed specifications for its construction, configuration and method of operation. These expressions were clearly separate from the idea of where to construct a transmitting tower. Moreover, the *WPOW* court found that the engineering report's specifications concerning the broadcasting radiation pattern were chosen from "an almost infinite number" of alternatives. Thus, there was no danger that granting copyright protection to the report would create a monopoly over the "idea" of broadcasting in a particular manner from a particular location. In contrast, the Commission in the instant case at the time the copying occurred had approved only one EIS corridor through which a pipeline could be built without additional time-consuming and costly environmental study. To extend copyright to the quad maps would grant Kern River a monopoly over the only approved pipeline route.

Since the quad maps in question are not copyrightable works, we need not reach the question whether Wy-Cal's use of the maps was fair use.

B

Kern River failed to show a substantial likelihood of success on the merits of its case for copyright infringement as its maps are not copyrightable. We pretermit any de-

cision on whether Kern River has met its burden on the remaining elements of a prima facie case for a preliminary injunction, and as to the merits of Kern River's misappropriation count against Wy-Cal and the other defendants.

IV

The order of the district court denying the preliminary injunction is

AFFIRMED.

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF TEXAS
HOUSTON DIVISION

CIVIL ACTION NO. H-89-0904

KERN RIVER GAS TRANSMISSION COMPANY,
Plaintiff,

VS.

THE COASTAL CORPORATION, COLORADO INTERSTATE CORPORATION, COLORADO INTERSTATE GAS COMPANY, COASTAL WESTERN PIPELINE COMPANY, COLORADO INTERSTATE GAS WESTERN PIPELINE COMPANY AND WYOMING-CALIFORNIA PIPELINE COMPANY,
Defendants.

MEMORANDUM AND ORDER

At the outset, this Court must place in perspective the narrow area of jurisdiction in which it may exercise authority. This Court notes that the issue to be addressed is whether the defendants should be enjoined for utilizing maps that the defendants developed as a result of copying of Plaintiff's maps. Any decision that this Court makes will not have the effect of impounding the certificate of public convenience and necessity that Wy-Cal has received; nor will it implicate the Natural Gas Act, impinge on the U.S. Court of Appeals jurisdiction, or curtail any order or report issued by the Federal Power Commission. Moreover, the fact that plaintiff seeks relief in this Court under one theory and the Court of Appeals utilizing the same factual basis or argument is of no moment. The relief sought in the Court of Appeals, if granted, may directly affect the defendants' optional certificate or its ability to proceed. In this regard, no jurisdictional conflicts exist

between this Court and the Court of Appeals or this Court and any federal agency.

In order for a party to prevail on a preliminary injunction the moving party must establish that: (1) there is a substantial likelihood that the moving party will prevail on the merits; (2) a substantial threat that irreparable injury will result if the injunction is not granted; (3) the threatened injury to the moving party, if the injunction does not issue, outweighs the threatened harm to the non-moving party upon issuance of the injunction; and (4) granting the injunction will not disturb the public interest.

It is the Court's conclusion that Kern River has failed to establish that irreparable injury will result if the injunction is not granted. The following are the findings of facts and conclusions of law associated with this holding.

FINDINGS OF FACT

1. The Kern River partnership was created by a "meeting of the minds" between Northwest Pipeline and Tenneco Inc. as early as mid-March 1985, with a subsequent written agreement reflecting the partnership's existence being signed on May 29, 1985. Employees assigned full-time to the Kern River Project and working under the direct supervision and control of the Kern River Partnership hierarchy drafted the first set of quad maps reflecting the proposed Kern River route starting in April 1985.

2. Pursuant to the Kern River partnership agreement, both Northwest Pipeline and Tenneco Inc. have been reimbursed for all expenses incurred on behalf of their subsidiaries or affiliates in relation to the Kern River Project, including the salaries of all employees assigned full-time to the Kern River project.

3. Plaintiff developed Kern River's Copyrighted Maps by conducting full, independent field work on every segment of its pipeline route from southwest Wyoming to Kern County, California.

4. Plaintiff's field work was conducted along all sections of its proposed pipeline route, including those segments which paralleled existing disturbances.

5. After Plaintiff's initial field investigation, employees of Northwest Pipeline and Tenneco Inc., assigned full-time to the Kern River Project, performed "pinpricking" of aerial photography taken along the proposed route. These "pin-pricked" maps were used to develop Kern River's 1986 Quad Maps.

6. Plaintiff has made a very limited distribution of its maps on a "need-to-know basis" and primarily to further the processing of its application to the FERC for a certificate of public convenience and necessity.

7. The FERC issued a final certificate of public convenience and necessity to Defendant Wy-Cal on March 15, 1989.

8. Defendant Wy-Cal's February, 1988 maps which were filed with Chambers and the FERC depicted substantial portions of Wy-Cal's proposed pipeline route to be outside of the approved EIS corridor.

9. As a result of being outside the corridor in its February 1988 Quad Maps, Defendants sent CIG draftsmen to the Chambers Group headquarters in Albuquerque, New Mexico to ascertain the exact location of the EIS corridor.

10. While in Albuquerque, New Mexico, the CIG draftsmen copied all Kern River maps reflecting the EIS corridor, including portions of Kern River's pipeline route in California clearly outside Wy-Cal's pipeline route as proposed to the FERC.

11. In addition to copying Kern River's proposed route between Mile Posts 50 and 500, Defendants have copied the entire Wasatch Variation and virtually all of the North Las Vegas Variation, both of which were developed entirely by Plaintiff Kern River.

12. In certain areas along Kern River's proposed pipeline route, geographical and topographical limitations could preclude two pipelines from being placed next to each other. Defendants' construction of a pipeline along the exact route depicted on Kern River's Copyrighted Maps could require Plaintiff Kern River to develop an alternative alignment at substantial cost which would be outside of the existing one mile wide EIS study corridor.

13. In January 1987, the Chambers group prepared and published the draft environmental impact statement (the "DEIS") in 4 volumes. These volumes established the Kern River Corridor in which each applicant's route is required to fall unless additional EIS studies are done.

14. On August 4, 1987, Wy-Cal filed an application with the FERC for an Optional Expedited Certificate.

15. In the Fall of 1987, Wy-Cal converted its Working Pencil Lines to a set of acetate overlays, on which the Wy-Cal proposed route was identified by removable map tape. These acetate overlays were created without reference to or use of any Kern River map.

16. In December of 1987, the FERC staff published the DEIS for, inter alia, the analysis corridor which Chambers had studied for the proposed Kern River route. Publication of the DEIS was significant in that it constituted FERC staff approval of the corridors and marked the end of environmental study of those corridors.

17. On December 14, 1987, the FERC gave notice that in light of Wy-Cal's decision to track existing analysis corridors for a large portion of its proposed route, the FERC would require environmental study only on those portions of the route (52 miles) which were represented to be outside of previously studied corridors.

18. In January 1988, Wy-Cal began to create 1:24,000 scale maps for those portions of its route which did not

track an existing analysis corridor as approved in the recently published DEIS.

19. On February 2, 1988, the FERC served a data request on Wy-Cal. It was the only data request the FERC served on Wy-Cal during its entire proceeding. It asked for quad maps for those portions of the route of Wy-Cal not represented to be common to the Kern River analysis corridor (primarily the stretch north of Interstate 80 in southwestern Wyoming), for the quad map which depicted each compressor station, and for its route in the vicinity of the Sunrise Mountain Instant Study Corridor. By reference to its 1:250,000 scale acetate overlays and the depiction on blank quad maps of existing disturbances, WyCal created the requested quads and included them in response to the data request. Thereafter, employing the same method, Wy-Cal prepared a complete set of quads (the February '88 Quads) for its entire route and sent that set out to the California State Lands Commission in connection with its right of way application. Wy-Cal prepared this set of quads without reference to or use of any Kern River maps.

20. On April 4, 1989, two Wy-Cal draftsmen visited the offices of Chambers in Albuquerque, New Mexico in order to plot the center line of the analysis corridors for the proposed Kern River and Mojave routes.

21. The maps provided to the draftsmen were, unbeknownst to Wy-Cal, a reduced scale version of what is referred to in this case as the Kern River 1986 Quads.

22. In creating the maps in Albuquerque, Wy-Cal reasonably believed that it was entitled to obtain the precise location of the center line of the analysis corridor.

23. Wy-Cal never had knowledge of claim of copyright in the maps prior to filing of this suit.

CONCLUSIONS OF LAW

Wy-Cal contends that Kern River is not the owner of the copyrights because it is not the owner of maps now the subject of the copyright claims. In this regard, Wy-Cal asserts that the maps do not qualify as works made for hire because the employees who performed the work were not employees of Kern River because no agreement existed between Kern River and Tenneco and Northwest Pipeline establishing ownership or the utilization of the corporations' employees. Additionally, Wy-Cal asserts that the Kern River's mapped route was copied from earlier works of different authors and are therefore not subject to copyright protection. This contention is without merit. Following this line of reasoning, work product of a person producing lines on a map would never be subject to copyright protection. Protection is sought for the lines drawn on the maps, not the United States Geologic Survey maps themselves. Every map that is ever made is a derivative to some degree. The fact that Kern River's route tracks portions of the Rocky Mountain route, the Ruchman-Painter Lateral, the Frontier Pipeline, the Mountain Fuel Pipeline and the All-American Pipeline is of no moment. The specific iterations on Kern River's maps are the result of its own work.

The Court agrees that the route that has been developed by Kern River is not subject to protection. However, Kern River's specific iterations on the maps representing its specific route may be the subject of copyright protection.

The Court is of the opinion that the Kern River route, as such, is an idea, expression of which is inseparable. Consequently, the doctrine of merger is applicable to the extent the larger maps, i.e., 1:250,000 scale maps, simply express or describe an idea. By this conclusion, the Court is holding that Wy-Cal could copy the 1:250,000 scale maps because they simply expressed an idea and in this size map the two are inseparable. The parties should note that

the mosaic map, Sluder Exh. 3, and other 1:250,000 scale map, would be viewed accordingly.

On the other hand, Wy-Cal should be barred from copying the 1:24,000 maps because the iterations and lines, although identical or nearly so, to prior unregistered 1985 quad maps, are copyrightable. It is the Court's view that a limited showing of the 1985 quad maps does not constitute publication. It is clear from the evidence that the 1:24,000 scale map were used on a very limited basis to satisfy environmental concern of the federal government as well as local government and civic associations. With the exception of the FERC, the quad map remained relatively unseen. In this regard, the Court concludes that no copies of the quad maps were sold, leased or given away such that publication was effected.

Assuming that each of Kern River's assertions are correct, no evidence was presented that Wy-Cal's copying of the Kern River's quad maps were necessary to the FERC approval process. It is noted that the certificate was issued to Wy-Cal on March 15, 1989 and that on April 4, 1989 the copying occurred. The evidence shows that Wy-Cal could have simply adopted the Kern River route and satisfied the application's requirements. The Court does not and is not ignoring the fact that copying was done, however. The Court is simply distinguishing between the adoption of the route and the copying of Kern River's iterations from the Kern River's 1:24,000 scale maps. At this point, the evidence does not establish the damages.

In this regard, considering the "totality of the circumstances," this Court concludes that the fair use doctrine is applicable. *Key Maps, Inc. v. Pruitt*, 470 F. Supp. 33 (S.D. Tex. 1978). It is reasonable to conclude that Wy-Cal intended only to copy or adopt the Kern River route, which this Court concludes was permissible. Moreover, the evidence shows that Wy-Cal was unaware of any copyright claim at the time that the copying was done.

Based on these findings and conclusions, the Court is of the opinion that, while Kern River may have suffered damages and may prevail at the time of trial on the merits, those damages will exist only if Kern River is required to alter its route, thereby requiring additional EIS work and approval, and if Kern River is issued a certificate of public necessity and convenience with which construction may commence.

The temporary restraining order is DISSOLVED and the injunction is DENIED. All impounded documents are ORDERED returned.

SIGNED this / 17th / day of July, 1989.

/ s /

KENNETH M. HOYT

United States District Judge

IN THE UNITED STATES COURT OF APPEALS
FOR THE FIFTH CIRCUIT

No. 89-2831

KERN RIVER GAS TRANSMISSION CO.,
Plaintiff-Appellant,

versus

THE COASTAL CORPORATION, *ET AL.*,
Defendants-Appellees.

Appeal from the United States District Court for the Southern District of Texas

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ON PETITION FOR REHEARING
(June 15, 1990)

Before CLARK, Chief Judge, THORNBERRY and JONES, Circuit Judges.

PER CURIAM:

IT IS ORDERED that the petition for rehearing filed in the above entitled and numbered cause be and the same is hereby denied.

ENTERED FOR THE COURT:

/s/ Charles Clark
United States Circuit Judge

CERTIFICATE OF COPYRIGHT REGISTRATION

[SEAL] This certificate, issued under the seal of the Copyright Office in accordance with the provisions of section 410(a) of title 17, United States Code, attests that copyright registration has been made for the work identified below. The information in this certificate has been made a part of the Copyright Office records.

FORM VA
UNITED STATES COPYRIGHT OFFICE
REGISTRATION NUMBER
VA 145 000
VAU

EFFECTIVE DATE OF REGISTRATION
February 7 1989

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1 TITLE OF THIS WORK

KERN RIVER NATURAL GAS PIPELINE QUADRANGLE MAPS - 1986

NATURE OF THIS WORK

Maps

• • •

2a NAME OF AUTHOR

Kern River Gas Transmission Company,
a Texas corporation

Was this contribution to the work a "work made for hire"?

Yes

AUTHOR'S NATIONALITY OR DOMICILE Name of Country

Citizen of United States

WAS THIS AUTHOR'S CONTRIBUTION TO THE WORK

Annomymous? No

Pseudonymous? No

NATURE OF AUTHORSHIP Briefly describe nature of the material created by this author in which copyright is claimed. Complete work

* * *

3 **YEAR IN WHICH CREATION OF THIS WORK WAS COMPLETED** (This information must be given in all cases.)

1986

DATE AND NATION OF FIRST PUBLICATION OF THIS PARTICULAR WORK (Complete this information ONLY if this work has been published)

Unpublished

4 **COPYRIGHT CLAIMANT(S)** Name and address must be given even if the claimant is the same as the author given in space 2.

Kern River Gas Transmission Company,
a Texas General Partnership
1010 Milam Street
Houston, Texas 77052

APPLICATION RECEIVED

FEB 07 1989

ONE DEPOSIT RECEIVED

FEB 07 1989

REMITTANCE NUMBER AND DATE

EXHIBIT D

5 **PREVIOUS REGISTRATION** Has registration for this work, or for an earlier version of this work, already been made in the Copyright Office?

No

* * *

6 **DERIVATIVE WORK OR COMPILATION** Complete both space 6a & 6b for a derivative work; complete only 6b for a compilation.

a. **Preexisting Material** Identify any preexisting work or works that this work is based on or incorporates.

Ground coordinates and ground control from U. S. geological survey maps, topographical lines, roads and all cartographic features exclusive of materials added by Kern River Gas Transmission Company.

b. **Material Added to This Work** Give a brief, general statement of the material that has been added to this work and in which copyright is claimed.

Remainder of cartographic authorship, consisting of Kern River project pipeline routes, mileposts, and embellishments in proximity to the pipeline routes.

7 **DEPOSIT ACCOUNT** If the registrtion fee is to be charged to a Deposit Account established in the Copyright Office, give name and number of Account

Name: Mason, Fenwick & Lawrence

Account Number: 18-414

CORRESPONDENCE Give name and address to which correspondence about this application should be sent.

J. Timothy Hobbs
Mason, Fenwick & Lawrence
1225 Eye Street, N. W., Suite 1000
Washington, D. C. 20005
(202) 289-1200

8 CERTIFICATION* I, the undersigned, hereby certify that I am the

authorized agent of Kern River Gas Transmission Company

Name of author or other copyright claimant, or owner of exclusive right(s)

of the work identified in this application and that the statements made by me in this application are correct to the best of my knowledge.

Typed or printed name and date If this is a published work, this date must be the same as or later than the date of publication given in space 3.

J. Timothy Hobbs /s/ J. T Hobbs 07 Feb. 1989

9 MAIL CERTIFICATE TO

J. Timothy Hobbs, Esq.
c/o Mason, Fenwick & Lawrence
1225 Eye Street, N. W., Suite 1000
Washington, D. C. 20005

* 17 U.S.C. § 506(e): Any person who knowingly makes a false representation of a material fact in the application for a copyright registration provided for by section 409, or any written statement filed in connection with the appliation, shall be fined not more than $2,500.